

REMARKS

This is in response to the Office Action mailed May 25, 2006. Claims 10-16 and 25 have been withdrawn. Claims 17, 21, and 22 have been amended. New claim 26 has been added. Claims 17-24 and 26 remain pending.

Support for the claim amendment can be found throughout the specification and specifically on page 2, lines 23-26 (the present invention relates to a powdered disinfectant containing a peracetic-acid generating system consisting of a peroxide and an acylating agent together with a nonionic surfactant); page 2, lines 10-18 (desire to provide a disinfectant composition in a short period of time); page 4 lines 3-9 (further auxiliary ingredients include alkalisng agents, complexing agents, corrosion inhibitors and surfactants); page 5, Example 1 (nonionic surfactant improves the dissolution rate of the powder in water); and page 1 line 4 (the present invention relates to a powdered disinfectant for use in the medical field). It is believed that no new matter is included in these amendments.

Election/Restrictions

Applicants elect with traverse Group II, claims 17-24 drawn to a method of disinfecting a surface for further prosecution in the present application. Claims 10-16, and 25 are therefore withdrawn from consideration but are not canceled. No fees are believed due for consideration of the present reply, however, if this is not the case please charge any such required fees, including any extension fees under 37 CFR subsection 1.136(a) to Deposit Account number 501257.

Claim Objections

Claims 21 and 22 are objected to because of the word “further.” Claims 21 and 22 have been amended to delete the word “further.” Accordingly, it is respectfully requested that this objection be withdrawn.

Rejections Under 35 U.S.C. §103

Lang et al. (U.S. Pat. No. 5,858,945)

The Office Action has rejected claims 17, 19-21, 23, and 24 under 35 U.S.C. § 103(a) as unpatentable over Lang et al. Applicants respectfully traverse this rejection.

Applicants invention is directed to peracid-generating powders that have improved dissolution over prior art powders. Example 1 shows that the improved dissolution is attributed in part to the use of the surfactant called out in claim 17.

Lang et al. is directed to peracid granules containing citric acid and an active peracid compound. See Lang et al., column 2, lines 41-46.

The Office Action notes that Lang et al. includes a discussion of surfactants. See Lang et al., columns 7-11 with nonionic surfactants discussed at column 8 line 19 to column 10 line 21. However, the surfactant discussion is very broad and includes a discussion on anionic surfactants, nonionic surfactants, amphoteric surfactants, zwitterionic surfactants, and cationic surfactants.

The Examples in the present invention show that the specific surfactant in claim 17 increases the dissolution rate and improves the disinfectant properties of the composition. Applicants do not see in the broad surfactant text where Lang et al. identifies the specific nonionic surfactant in claim 17 as useful in increasing the dissolution rate of the powder. Example 1 in the present invention tests the dissolution rate of a perborate/TAED composition

(1) without a surfactant, (2) with an anionic surfactant, and (3) with the nonionic surfactant of the present invention. The compositions without a surfactant and with an anionic surfactant dissolved in over an hour where the composition with the nonionic surfactant dissolved in less than an hour. See Applicants invention page 5. Applicants do not believe that five columns of general surfactant text render the specific type of surfactant in the present invention obvious for improving the dissolution rate of a powder. There is no motivation to pick that particular surfactant out of the surfactant discussion in Lang et al. for the purpose that it is included in the present invention. Further, there is nothing in the surfactant discussion in Lang et al. that would lead a person skilled in the art to use that surfactant for the purpose that it is included in the present invention with a reasonable likelihood of success. Both a motivation and a reasonable likelihood of success are needed in order to make a prima facie obviousness case. In addition to not distinguishing the specific surfactant in claim 17, Lang et al. teaches that some of the alcohol nonionic surfactants can be used together with anionic surfactants. See Lang et al., column 8, lines 50-51. It is clear from this statement that Lang et al. did not teach the use of nonionic surfactants to improve dissolution rates where Example 1 shows that the anionic surfactant did not contribute to improving the dissolution rate.

Example 2 on page 6 of Applicants invention shows that the composition with the surfactant of the present invention was a better disinfectant than the composition without surfactant. Applicants do not believe that five columns of general surfactant text render the specific type of surfactant in the present invention obvious for improving the disinfecting properties of the present invention for the same reasons discussed above with respect to dissolution rates.

Applicants have amended claim 17 to clarify that the present invention is directed to a peracid-generating powder composition and that the powder composition does not actually include peracid, but rather forms peracid when the powder is placed in water. Applicants have also amended claim 17 to specify surfaces in the medical field. Applicants believe that these remarks and amendments distinguish the present invention from Lang et al. Accordingly, it is respectfully requested that this rejection be withdrawn.

MacBeath (U.S. Pat. No. 5,747,438)

The Office Action has rejected claims 17 and 19-24 under 35 U.S.C. § 103(a) as unpatentable over MacBeath. Applicants respectfully traverse this rejection.

MacBeath is directed to a particulate solid machine dishwashing detergent comprising, among other things, (1) a coated percarbonate bleach where the coating is a mixed salt comprising an alkali metal carbonate and an alkali metal sulfate salt and (2) a means for enabling delayed release of an acidification agent. See MacBeath abstract. According to MacBeath, the coating provides for storage stability of the percarbonate in granular form. See MacBeath column 2, lines 59-61. The means for delayed release of the acidification agent can include a coating, mechanical means, and blending of the acid with a less soluble compound. See MacBeath column 4, lines 34-35 and lines 63-65 and column 5, lines 8-10. MacBeath teaches that a coated percarbonate bleach and a delayed release acid are needed in order to keep the percarbonate stable and maintain good cleaning performance. See MacBeath column 2, lines 5-10. This teaching teaches away from the present invention which is designed to solve the problems of the prior art powdered systems which dissolve very slowly in water and/or leave undissolved residue in the system. See Applicants invention page 2 lines 10-15. According to Applicants invention, powdered systems that dissolve slowly are a problem because they delay

when the disinfectant composition is available to be used. See Applicants invention page 2 lines 10-15. In other words, if a powdered system is dissolved in water to form a disinfectant composition that is intended to be used, for example, on medical instruments, but the powder does not dissolve in a short time, the power of the disinfectant concentration may not be strong enough at the time of use to properly disinfect the medical instrument, thus increasing the risk of transferring infection from the previous patient to the next. Therefore, one of the objects of the present invention is to provide a disinfectant composition within a short period of time and minimize the risk of residues in the system or on surfaces. See Applicants invention page 2 lines 16-18. MacBeath deliberately tries to delay the release of the raw materials for the reasons discussed above. Further, MacBeath is not directed to a method of disinfecting, but rather to cleaning and bleaching. See MacBeath, column 2, lines 5-10. This is significant because it is another example of why MacBeath does not appreciate the importance of having an adequate disinfectant composition in a short period of time.

Applicants have amended claim 17 to call out that the nonionic surfactant is present in an amount sufficient to improve the dissolution of the powder composition in water. Applicants have also amended claim 17 to call out a method of disinfecting a surface in the medical field. Finally, Applicants have amended the claims to call out an uncoated peroxide. Applicants believe that these remarks and amendments distinguish the present invention from MacBeath. Accordingly, it is respectfully requested that this rejection be withdrawn.

Remaining 103(a) References

The Office Action makes several other rejections under 35 U.S.C. §103(a) in light of Okauchi et al., Biering et al., or Biering et al. in combination with Lang et al. Applicants respectfully traverse these rejections.

Applicants believe that the present invention is distinguished from Lang et al. for the reasons discussed above. Applicants do not believe that the shortcomings of Lang et al. are remedied by the prior art references of record. With respect to Biering et al. (US 6,908,891), Applicants have amended claim 17 to no longer include a product-by-process limitation.

For these reasons, and the reasons discussed above with respect to Lang et al., Applicants respectfully request that these rejections be withdrawn.

Obviousness-Type Double Patenting Rejection

The Office Action has rejected multiple claims under the judicially created doctrine of obviousness-type double patenting. Applicants respectfully traverse this rejection. Applicants believe that the arguments and amendments presented herein distinguish the present invention from US 6,540,660 for the reasons discussed above. Accordingly, it is respectfully requested that this rejection be withdrawn.

Summary

It is respectfully submitted that each of the pending claims is in condition for allowance, and notification to that effect is kindly requested. The Examiner is invited to contact the Applicants' primary attorney-of-record, Anneliese S. Mayer, at (651) 795-5661, if it is believed that prosecution of this application may be assisted thereby.

Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers or any future reply, if appropriate. Please charge any additional fees or credit overpayment to Deposit Account No. 501257.



Respectfully submitted,

ECOLAB INC.
Law Department
Mail Stop ESC-F7
655 Lone Oak Drive
Eagan, Minnesota 55121
Phone Number: (651) 795-5661
Fax Number: (651) 204-7507

Dated: July 24, 2006

By: /Anneliese S. Mayer/
Name: Anneliese S. Mayer
Reg. No. 54,434